

Attorney Docket No. YOR920000056US1REMARKS

The present application was filed on January 5, 2001 with claims 1-42. In the outstanding Office Action dated December 4, 2002, the Examiner: (i) rejected claims 1-42 under 35 U.S.C. §112, second paragraph, as being indefinite; (ii) rejected claims 1-5, 7-11, 13-15, 17-20, 22-26, 28-32, 34-36 and 38-41 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,838,819 to Ruedisueli et al (hereinafter "Ruedisueli"); and (iii) indicated that claims 6, 12, 16, 21, 27, 33, 37 and 42 contain allowable subject matter.

In this response, Applicants: (i) amend claims 1-3, 7, 8, 14, 18, 22-24, 28, 29, 35 and 39; (ii) add new claims 43-50; and (iii) traverse the various rejections for at least the reasons given below.

Applicants thank Examiner Bell for acknowledging allowable subject matter in claims 6, 12, 16, 21, 27, 33, 37 and 42. Applicants have rewritten claims 6, 12, 16, 21, 27, 33, 37 and 42 in independent form (including all intervening claims) as new claims 43-50. Claims 43-50 incorporate the amendments presented herein to overcome the §112, second paragraph, with respect to the alleged indefiniteness of the term "natural."

Regarding the §112, second paragraph, rejection of claims 1-42, Applicants have amended the relevant claims to remove the terms "natural," "naturally," and/or "-like." Accordingly, withdrawal of the §112, second paragraph, rejection of claims 1-42 is respectfully requested.

Regarding the §102(b) rejection of claims 1-5, 7-11, 13-15, 17-20, 22-26, 28-32, 34-36 and 38-41, Applicants believe that said claims, as originally filed, are patentable over the cited reference. Nonetheless, Applicants have amended independent claims 1, 18, 22 and 39 to further clarify the subject matter of the invention. Support for the amendments can be found throughout the specification, for example, see page 5, lines 8-25; and page 10, line 24, through page 11, line 6.

By way of example, claim 1 recites a method of entering formatted electronic ink data provided in association with a user on a handwriting system which comprises, *inter alia*, the one or more pieces of writing medium being configured to have a predefined format including one or more fields associated with the predefined format . . . wherein a field comprises a delimited area of the writing medium, and the step of providing one or more user-specified indications to indicate that electronic ink data entered in association with the one or more user-specified indications is to

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be associated with the one or more fields, so as to permit a transition between the entry of electronic ink data in accordance with the one or more fields and entry of electronic ink data that is not associated with the one or more fields. Claims 18, 22 and 39 provide similar limitations.

Ruedisueli discloses something significantly different. While Ruedisueli relates to a technique for processing and managing electronic copies of handwritten notes in accordance with a handwriting system, Ruedisueli addresses the issue of maintaining synchrony between ink notes on a physical page and the virtual, electronic version of that page. That is, Ruedisueli discloses a technique for assigning writing "sessions" to specific pages, tracking of correct correspondences between the paper copies of notes and the electronic copies (see column 1, lines 38-52), and managing pages electronically stored (see column 1, lines 55-61). See also column 2, lines 10-19, where Ruedisueli states that "each session corresponds with a time period during which a collection of notes are made without being interrupted for the purpose of making a second collection of notes."

On the other hand, the claimed invention recites that the one or more pieces of writing medium are configured to have a predefined format including one or more fields associated with the predefined format . . . wherein a field comprises a delimited area of the writing medium, and the step of providing one or more user-specified indications (e.g., one or more tags or some form of signaling) to indicate that electronic ink data entered in association with the one or more user-specified indications is to be associated with the one or more fields, so as to permit a transition between the entry of electronic ink data in accordance with the one or more fields and entry of electronic ink data that is not associated with the one or more fields.

Advantageously, the claimed invention thus provides annotation of handwritten data for a variety of purposes, in which multiple user-specified indications (e.g., one or more tags or some form of signaling) can be made within a given session and/or page, or can be inserted at a later time. Such user-specified indications may be used to label data to a specific purpose, can have a variety of purposes, are not limited to handwritten entries, can be added at any time and are not restricted to be associated with a session associated to a specific page, can be entered in one session, and can be attached to the same set (or intersecting sets) of strokes.

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As is evident, there is a significant difference between the claimed invention and Ruedisueli since Ruedisueli relates to a technique for overcoming the problem of associating virtual ink to the correct/corresponding page. On the other hand, the claimed invention employs fields (comprising delimited areas of the writing medium) and user-specified indications so as to permit a transition between the entry of electronic ink data in accordance with the one or more fields and entry of electronic ink data that is not associated with the one or more fields. This is neither the problem that Ruedisueli addresses nor the solution that Ruedisueli offers to solve its problem.

The Office Action refers to figure 4, items 40 and 42, in Ruedisueli, for rejecting the concept of user-specified indications. However, since items 40 and 42 in Ruedisueli refer solely to the detection of writing on a page (not to the detection of an annotation mark or signal) and to the detection of a shut-down command ceasing the operation of the whole gathering of writing (not to the detection of an annotation mark or signal delimiting the annotated ink, while allowing further writing), it is asserted that such items are unrelated to the concept of user-specified indications and fields, as recited in the claims.

Furthermore, Applicants assert that the claims which depend from independent claims 1, 18, 22 and 39 are not only patentable over the cited reference in view of the above reasons, but also because such dependent claims recite patentable subject matter in their own right.

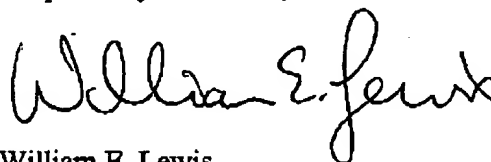
Accordingly, withdrawal of the §102(b) rejection of claims 1-5, 7-11, 13-15, 17-20, 22-26, 28-32, 34-36 and 38-41 is respectfully requested.

Attached hereto is a marked-up version of the changes made to the claims by the present Amendment.

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In view of the above, Applicants believe that claims 1-50 are in condition for allowance, and respectfully request favorable reconsideration.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "William E. Lewis". The signature is fluid and cursive, with the first name "William" being the most prominent.

Date: April 4, 2003

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Attorney Docket No. YOR920000056US1VERSION WITH MARKINGS TO SHOW CHANGES MADEIN THE CLAIMS

Please amend claims 1-3, 7, 8, 14, 18, 22-24, 28, 29, 35 and 39 as follows:

1. (Amended) A method of entering formatted electronic ink data provided in association with a user on a handwriting system, the method comprising the steps of:

positioning one or more pieces of writing medium to substantially overlay at least a portion of a digitizing surface associated with the handwriting system; [and]

physically entering handwritten data on the one or more pieces of writing medium using a stylus associated with the handwriting system such that, substantially simultaneous therewith, the electronic ink data representing the physically entered handwritten data is entered at the digitizing surface;

wherein the one or more pieces of writing medium [being] are configured to have a predefined format including one or more fields associated with the predefined format such that the electronic ink data entered at the digitizing surface is computer-parseable based on the one or more fields, and further wherein a field comprises a delimited area of the writing medium; and

[and the one or more pieces of writing medium being further configured] providing one or more user-specified indications to indicate that electronic ink data entered in association with the one or more user-specified indications is to be associated with the one or more fields, so as to permit a [natural] transition between the entry of electronic ink data in accordance with the one or more fields and entry of electronic ink data that is not associated with the one or more fields.

2. (Amended) The method of claim 1, wherein at least one of the pieces of writing medium has the predefined format for entry of electronic ink data in accordance with the one or more fields and at least one of the pieces of writing medium does not have the predefined format, such that the user may [naturally] transition between the two pieces of writing medium when performing formatted electronic ink data entry and unformatted electronic ink data entry, respectively.

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3. (Amended) The method of claim 1, wherein the one or more fields of the one or more pieces of writing medium are preprinted in watermark[-type] form thereon, such that the user may [naturally] transition between performing formatted electronic ink data entry and unformatted electronic ink data entry on the same piece of writing medium.

7. (Amended) The method of claim 1, wherein the user-specified indication providing step further [comprising] comprises the step of the user signaling the beginning of entry of formatted electronic ink data in accordance with the one or more fields.

8. (Amended) The method of claim 1, wherein the user-specified indication providing step further [comprising] comprises the step of the user signaling completion of entry of formatted electronic ink data in accordance with the one or more fields.

14. (Amended) The method of claim 1, wherein the one or more pieces of writing medium are bound together to form a [pad-like] grouping.

18. (Amended) A method of entering formatted electronic ink data provided in association with a user on a handwriting system, the method comprising the steps of:

positioning one or more pieces of writing medium to substantially overlay at least a portion of a digitizing surface associated with the handwriting system;

physically entering handwritten data on the one or more pieces of writing medium using a stylus associated with the handwriting system such that, substantially simultaneous therewith, the electronic ink data representing the physically entered handwritten data is entered at the digitizing surface; and

providing one or more user-specified indications [in accordance with the one or more pieces of writing medium] to indicate that electronic ink data entered in association with the one or more user-specified indications is to be associated with one or more fields of a predefined format, wherein a field comprises a delimited area of the writing medium, such that the electronic ink data entered

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in association therewith at the digitizing surface is computer-parseable based on the one or more fields, and such as to permit a [natural] transition between the entry of electronic ink data in accordance with the one or more fields and entry of electronic ink data that is not associated with the one or more fields.

22. (Amended) A handwriting system for entering formatted electronic ink data provided in association with a user, the system comprising:

a digitizing surface;

a stylus; and

one or more pieces of writing medium;

wherein the one or more pieces of writing medium are positioned to substantially overlay at least a portion of the digitizing surface such that handwritten data can be physically entered on the one or more pieces of writing medium using the stylus such that, substantially simultaneous therewith, the electronic ink data representing the physically entered handwritten data is entered at the digitizing surface;

further wherein the one or more pieces of writing medium are configured to have a predefined format including one or more fields associated with the predefined format such that the electronic ink data entered at the digitizing surface is computer-parseable based on the one or more fields, wherein a field comprises a delimited area of the writing medium, [and the one or more pieces of writing medium are further configured] such that one or more user-specified indications can be provided to indicate that electronic ink data entered in association with the one or more user-specified indications is to be associated with the one or more fields, so as to permit a [natural] transition between the entry of electronic ink data in accordance with the one or more fields and entry of electronic ink data that is not associated with the one or more fields.

23. (Amended) The system of claim 22, wherein at least one of the pieces of writing medium has the predefined format for entry of electronic ink data in accordance with the one or more fields

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and at least one of the pieces of writing medium does not have the predefined format, such that the user may [naturally] transition between the two pieces of writing medium when performing formatted electronic ink data entry and unformatted electronic ink data entry, respectively.

24. (Amended) The system of claim 22, wherein the one or more fields of the one or more pieces of writing medium are preprinted in watermark[-type] form thereon, such that the user may [naturally] transition between performing formatted electronic ink data entry and unformatted electronic ink data entry on the same piece of writing medium.

28. (Amended) The system of claim 22, wherein, in accordance with the one or more user-specified indications, the system is further operative to permit the user to signal the beginning of entry of formatted electronic ink data in accordance with the one or more fields.

29. (Amended) The system of claim 22, wherein, in accordance with the one or more user-specified indications, the system is further operative to permit the user to signal completion of entry of formatted electronic ink data in accordance with the one or more fields.

35. (Amended) The system of claim 22, wherein the one or more pieces of writing medium are bound together to form a [pad-like] grouping.

39. (Amended) A handwriting system for entering formatted electronic ink data provided in association with a user, the system comprising:

a digitizing surface;

a stylus; and

one or more pieces of writing medium;

wherein the one or more pieces of writing medium are positioned to substantially overlay at least a portion of the digitizing surface such that handwritten data can be physically entered on the one or more pieces of writing medium using the stylus such that, substantially simultaneous

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therewith, the electronic ink data representing the physically entered handwritten data is entered at the digitizing surface;

further wherein one or more user-specified indications can be provided [in accordance with the one or more pieces of writing medium] to indicate that electronic ink data entered in association with the one or more user-specified indications is to be associated with one or more fields of a predefined format, wherein a field comprises a delimited area of the writing medium, such that the electronic ink data entered in association therewith at the digitizing surface is computer-parseable based on the one or more fields, and such as to permit a [natural] transition between the entry of electronic ink data in accordance with the one or more fields and entry of electronic ink data that is not associated with the one or more fields.

Please add new claims 43-50 as follows:

--43. (New) A method of entering formatted electronic ink data provided in association with a user on a handwriting system, the method comprising the steps of:

positioning one or more pieces of writing medium to substantially overlay at least a portion of a digitizing surface associated with the handwriting system; and

physically entering handwritten data on the one or more pieces of writing medium using a stylus associated with the handwriting system such that, substantially simultaneous therewith, the electronic ink data representing the physically entered handwritten data is entered at the digitizing surface;

the one or more pieces of writing medium being configured to have a predefined format including one or more fields associated with the predefined format such that the electronic ink data entered at the digitizing surface is computer-parseable based on the one or more fields, and the one or more pieces of writing medium being further configured to permit a transition between the entry of electronic ink data in accordance with the one or more fields and entry of electronic ink data that is not associated with the one or more fields;

wherein the one or more fields of the predefined format are associated with a label, the label is associated with an information management function, and the information management function

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comprises at least one of an appointment recording function, a phone message recording function and a listing function of tasks to be accomplished.

44. (New) A method of entering formatted electronic ink data provided in association with a user on a handwriting system, the method comprising the steps of:

positioning one or more pieces of writing medium to substantially overlay at least a portion of a digitizing surface associated with the handwriting system;

physically entering handwritten data on the one or more pieces of writing medium using a stylus associated with the handwriting system such that, substantially simultaneous therewith, the electronic ink data representing the physically entered handwritten data is entered at the digitizing surface; and

the one or more pieces of writing medium being configured to have a predefined format including one or more fields associated with the predefined format such that the electronic ink data entered at the digitizing surface is computer-parseable based on the one or more fields, and the one or more pieces of writing medium being further configured to permit a transition between the entry of electronic ink data in accordance with the one or more fields and entry of electronic ink data that is not associated with the one or more fields;

providing the user with feedback relating to the user's entry of formatted electronic ink data in accordance with the one or more fields, wherein the feedback relates to whether or not the user has completed one or more required fields.

45. (New) A method of entering formatted electronic ink data provided in association with a user on a handwriting system, the method comprising the steps of:

positioning one or more pieces of writing medium to substantially overlay at least a portion of a digitizing surface associated with the handwriting system; and

physically entering handwritten data on the one or more pieces of writing medium using a stylus associated with the handwriting system such that, substantially simultaneous therewith, the electronic ink data representing the physically entered handwritten data is entered at the digitizing surface; and

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the one or more pieces of writing medium being configured to have a predefined format including one or more fields associated with the predefined format such that the electronic ink data entered at the digitizing surface is computer-parseable based on the one or more fields, and the one or more pieces of writing medium being further configured to permit a transition between the entry of electronic ink data in accordance with the one or more fields and entry of electronic ink data that is not associated with the one or more fields;

wherein at least one of the pieces of writing medium has an at least partially adhesive backing.

46. (New) A method of entering formatted electronic ink data provided in association with a user on a handwriting system, the method comprising the steps of:

positioning one or more pieces of writing medium to substantially overlay at least a portion of a digitizing surface associated with the handwriting system;

physically entering handwritten data on the one or more pieces of writing medium using a stylus associated with the handwriting system such that, substantially simultaneous therewith, the electronic ink data representing the physically entered handwritten data is entered at the digitizing surface;

providing one or more user-specified indications in accordance with the one or more pieces of writing medium to indicate that electronic ink data entered in association with the one or more user-specified indications is to be associated with one or more fields of a predefined format, such that the electronic ink data entered in association therewith at the digitizing surface is computer-parseable based on the one or more fields, and such as to permit a natural transition between the entry of electronic ink data in accordance with the one or more fields and entry of electronic ink data that is not associated with the one or more fields; and

permitting at least one of user addition, deletion and modification of one or more fields.

47. (New) A handwriting system for entering formatted electronic ink data provided in association with a user, the system comprising:

a digitizing surface;

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a stylus; and

one or more pieces of writing medium;

wherein the one or more pieces of writing medium are positioned to substantially overlay at least a portion of the digitizing surface such that handwritten data can be physically entered on the one or more pieces of writing medium using the stylus such that, substantially simultaneous therewith, the electronic ink data representing the physically entered handwritten data is entered at the digitizing surface;

wherein the one or more pieces of writing medium are configured to have a predefined format including one or more fields associated with the predefined format such that the electronic ink data entered at the digitizing surface is computer-parseable based on the one or more fields, and the one or more pieces of writing medium are further configured to permit a transition between the entry of electronic ink data in accordance with the one or more fields and entry of electronic ink data that is not associated with the one or more fields;

wherein the one or more fields of the predefined format are associated with a label, the label is associated with an information management function, and the information management function comprises at least one of an appointment recording function, a phone message recording function and a listing function of tasks to be accomplished.

48. (New) A handwriting system for entering formatted electronic ink data provided in association with a user, the system comprising:

a digitizing surface;

a stylus; and

one or more pieces of writing medium;

wherein the one or more pieces of writing medium are positioned to substantially overlay at least a portion of the digitizing surface such that handwritten data can be physically entered on the one or more pieces of writing medium using the stylus such that, substantially simultaneous therewith, the electronic ink data representing the physically entered handwritten data is entered at the digitizing surface;

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wherein the one or more pieces of writing medium are configured to have a predefined format including one or more fields associated with the predefined format such that the electronic ink data entered at the digitizing surface is computer-parseable based on the one or more fields, and the one or more pieces of writing medium are further configured to permit a transition between the entry of electronic ink data in accordance with the one or more fields and entry of electronic ink data that is not associated with the one or more fields;

wherein the user can be provided with feedback relating to the user's entry of formatted electronic ink data in accordance with the one or more fields, further wherein the feedback relates to whether or not the user has completed one or more required fields.

49. (New) A handwriting system for entering formatted electronic ink data provided in association with a user, the system comprising:

a digitizing surface;

a stylus; and

one or more pieces of writing medium;

wherein the one or more pieces of writing medium are positioned to substantially overlay at least a portion of the digitizing surface such that handwritten data can be physically entered on the one or more pieces of writing medium using the stylus such that, substantially simultaneous therewith, the electronic ink data representing the physically entered handwritten data is entered at the digitizing surface;

wherein the one or more pieces of writing medium are configured to have a predefined format including one or more fields associated with the predefined format such that the electronic ink data entered at the digitizing surface is computer-parseable based on the one or more fields, and the one or more pieces of writing medium are further configured to permit a transition between the entry of electronic ink data in accordance with the one or more fields and entry of electronic ink data that is not associated with the one or more fields;

wherein at least one of the pieces of writing medium has an at least partially adhesive backing.

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50. (New) A handwriting system for entering formatted electronic ink data provided in association with a user, the system comprising:

a digitizing surface;

a stylus; and

one or more pieces of writing medium;

wherein the one or more pieces of writing medium are positioned to substantially overlay at least a portion of the digitizing surface such that handwritten data can be physically entered on the one or more pieces of writing medium using the stylus such that, substantially simultaneous therewith, the electronic ink data representing the physically entered handwritten data is entered at the digitizing surface;

wherein one or more user-specified indications can be provided in accordance with the one or more pieces of writing medium to indicate that electronic ink data entered in association with the one or more user-specified indications is to be associated with one or more fields of a predefined format, such that the electronic ink data entered in association therewith at the digitizing surface is computer-parseable based on the one or more fields, and such as to permit a natural transition between the entry of electronic ink data in accordance with the one or more fields and entry of electronic ink data that is not associated with the one or more fields;

wherein the system is further operative to permit at least one of user addition, deletion and modification of one or more fields.--